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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,209	03/15/2002	Hideki Hirano	1155-0245P	1052
2292	7590	07/23/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			MULLIS, JEFFREY C	
			ART UNIT	PAPER NUMBER
			1711	
DATE MAILED: 07/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/088,209

Applicant(s)

HIRANO ET AL.

Examiner

Jeffrey C. Mullis

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 09 July 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1-8.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-8.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Jeffrey C. Mullis  
J Mullis  
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ATTACHMENT TO ADVISORY ACTION

Applicants' arguments filed 7-9-04 have been fully considered but they are not deemed to be persuasive.

Applicants argue that blending the graft copolymer B with the thermoplastic resin A in the above amounts permits the liquid ethylene/alphaolefin random copolymer C to be dispersed homogeneously in the resin A without the occurrence of phase separation. However both primary references, one of which is the closest prior art, contains both components A and both components B. Therefore unexpected results due to addition of component A or component B is immaterial to patentability. Unexpected results must be with the closest prior art and not with other prior art, MPEP § 716. With regard to allegations of unexpected results due to addition of component C in which mold releasability is improved, such an unexpected result is disclosed by the secondary reference and is therefore not unexpected. Applicants do not appear to allege any unexpected results that are unrelated to increased mold releasability due to addition of component C. Applicants argue that Kato is silent with respect to the presence of liquid ethylene/alphaolefin random copolymer C. However the test for obviousness is what would occur to those of ordinary skill when viewing the combination of references, not first one reference and then the other. At the bottom of page 10

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of applicants' remarks applicants renew their arguments that unexpected results accrue due to use of component B. However both primary references use component B and therefore unexpected results due to addition of B is immaterial to patentability. Applicants argue that in comparative Example 7 the coefficient of dynamic friction as to high abrasion loss is too great. However as the secondary reference suggests, mold releasability would be increased by use of component C. Therefore such results are not unexpected although they may be improved. Applicants argue that unless the ethylene alphaolefin random copolymer C and the graft copolymer B are used "in combination" it is difficult to improve the sliding properties, wear resistant properties and impact resistance of articles. If applicants are implying that sliding properties, wear resistance and impact resistance of articles are unexpectedly improved by adding a combination of B and C (i.e. a "combination"), then such results are immaterial to patentability since the references teach a combination of component A and component B. Comparison of the effects of use of components B and C in combination upon addition to component A is immaterial to patentability since the closest prior art does not teach a composition containing only component A. Again unexpected results must be with the closest prior art and not with other prior art, MPEP § 716. In the first complete paragraph on page

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14 applicants argue unexpected results due to the presence of component B-1. However the closest prior art uses a component identical to applicants' component B-1 and therefore unexpected results due to the presence of component B-1 is immaterial to patentability. Applicants argue that the polar groups in the liquid ethylene-alphaolefin random copolymer of Hirano are low molecular weight and accordingly do not improve the compatibility between the thermoplastic polyester resin A and the liquid ethylene alphaolefin random copolymer C. However it is not the position of the Examiner that the liquid ethylene alphaolefin copolymer of Hirano corresponds to applicants' component B.

Applicants argue that Hirano et al. teaches away from a composition which contains a mixture of two or more of the above resins. However two or more of the above resins do not appear in the primary reference and it is unclear how applicants have concluded that the reference teaches away from the instant invention. Applicants argue that Hirano attempts to address the problem of incompatibility by inclusion of polar groups in the low molecular weight resin and by contrast applicants address the problem by further inclusion of a mixture of thermoplastic polyester resin A and low molecular weight ethylene alphaolefin copolymer C. It is not clear what the pertinence of applicants' argument is to patentability. If applicants are arguing that the

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Office may only make a proposed modification to a reference for the same reason as those of an applicant, this is incorrect. An invention which is obvious for one reason is obvious for all reasons. It is therefore immaterial how Hirano overcomes the problem of phase separation. Furthermore applicants' claims do not exclude grafting in component C of the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Mullis whose telephone number is (571) 272-1075. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (571) 272-1078. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0994.

J. Mullis:cdc

July 17, 2004

Jeffrey Mullis  
Primary Examiner  
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